

REMARKS

Claims 29-36, 39, 41-46 and 49-51 are pending.

Claims 29-36, 39 and 41-46 and 49-51 stand rejected under 35 U.S.C. 112, first paragraph, as lacking written description and enablement. Applicants respectfully traverse these rejections.

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 514 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”).

The Examiner continues to demand description of “a DNA sequence as claimed.” Applicants note that claims 29-31, in particular, are not directed to “a DNA sequence,” but rather to a process for producing a herbicide/fungicide-tolerant plant. The enclosed declaration establishes that one of ordinary skill in the art would have recognized that applicants had possession of the claimed invention.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the [application] coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). “Enablement is not precluded by the necessity for some experimentation such as routine screening.” *In re*

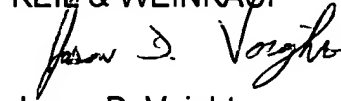
Wands, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988). In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The examiner should always look for enabled, allowable subject matter and communicate to application what that subject matter is at the earliest possible point in the prosecution. MPEP 2164.04.

In the Office action of July 17, 2001, the Examiner only specifically addresses claim 46 and concludes that one of skill in the art would not be able to reisolate a specific nucleotide encoding sequence of the claimed plant. Applicants again note that claims 29-31, in particular, are not directed to a DNA sequence, but rather to a process for producing a herbicide/fungicide-tolerant plant. Furthermore, applicants have amended claim 32, from which claim 46 ultimately depends, to require that the nucleotide encoding sequence in question be produced by the process of claim 29. The process does not require advance knowledge of a DNA sequence, but rather the specification provides guidance as to how to obtain such a sequence and use it to transform a plant. The Examiner gives no explanation supporting a conclusion that one reasonably skilled in the art could not make or use said process without undue experimentation. As evidenced by the enclosed declaration, one of ordinary skill in the art would have understood the process steps involved and been able to practice the invention.

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Respectfully submitted,

KEIL & WEINKAUF

A handwritten signature in cursive script, appearing to read "Jason D. Voight", is written over the printed name.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

32. (thrice amended) An expression cassette for plants, comprising a promoter, a nucleotide sequence encoding a signal peptide, a gene encoding an exogenous methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide or a part thereof produced according to steps a)-c) of claim [1] 29, and a nucleotide sequence encoding an ER retention signal and a terminator.

COPY OF ALL CLAIMS

29. A process for the production of a methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-tolerant plant, said process comprising transforming a plant with a gene encoding a methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide, whereby said polypeptide and the corresponding gene encoding said polypeptide is produced exogenously and isolated by the following steps:

- a) immunizing an animal with methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F) to produce a polyclonal serum of said polypeptide,
- b) producing a monoclonal cell line to produce a specific, monoclonal methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide,
- c) isolating the mRNA encoding said monoclonal polypeptide of step b) from said monoclonal cells and synthesizing the corresponding cDNA encoding said polypeptide.

30. The process as claimed in claim 29, wherein the methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide is a single-chain antibody fragment.

31. The process as claimed in claim 29, wherein the methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide is a complete antibody or a binding fragment of a complete antibody.

32. (thrice amended) An expression cassette for plants, comprising a promoter, a nucleotide sequence encoding a signal peptide, a gene encoding an exogenous methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide or a part thereof produced according to steps a)-c) of claim 29, and a nucleotide sequence encoding an ER retention signal and a terminator.

33. The expression cassette as claimed in claim 32, wherein the promoter is constitutive.

34. The expression cassette as claimed in claim 32, wherein the gene encodes a single-chain antibody fragment.

35. The expression cassette as claimed in claim 32, wherein the gene encodes a fusion protein comprising a methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide or a part thereof and at least one other functional protein or a part thereof selected from the group consisting of enzymes, toxins, chromophores and binding proteins.

36. The expression cassette as claimed in claim 32, wherein the gene is isolated from a hybridoma cell or with the aid of other recombinant methods.

39. A selection marker comprising the expression cassette as claimed in claim 32.

41. A process for the transformation of a plant or cells of a plant, said process comprising introducing a gene sequence which encodes a methyl

methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide into the plant or the cells of the plant.

42. The process as claimed in claim 41, wherein the introducing is effected by an *Agrobacterium*.

43. The process as claimed in claim 41, wherein the introducing is effected by electroporation.

44. The process as claimed in claim 41, wherein the introducing is effected by the particle bombardment method.

45. A process for production of a methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide, said process comprising transforming a plant or cells of a plant with a gene which encodes such a polypeptide and subsequently isolating the polypeptide.

46. A plant comprising the expression cassette as claimed in claim 33, wherein the expression cassette imparts increased tolerance to the plant, relative to a wild type or non-transformed plant, against methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F).

49. The process as claimed in claim 41, wherein the gene sequence which encodes a methyl methoxyimino- α -(o-tolyloxy)-o-tolylacetate (BAS 490F)-binding polypeptide is part of an expression cassette which also comprises a signal peptide, an ER retention signal and a terminator.

50. The process as claimed in claim 42, wherein the *Agrobacterium* is of the species *Agrobacterium tumefaciens*.

51. The expression cassette as claimed in claim 33, wherein the constitutive promoter is the CaMV 35S promoter.